

REMARKS

As a preliminary matter, it is noted that the Examiner has not initialed the prior art reference EP 0 875 997 listed in the Information Disclosure Statement filed on July 2, 2004. It is respectfully requested that the Examiner provide Applicants another initialed copy of the IDS indicating that EP 0 875 997 cited therein has been considered and made of record.

Claim 3 and 12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Soumyanath et al. '892 ("Soumyanath"), and claims 5 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Soumyanath. Solely in order to expedite issuance of this application, claims 12 and 14 have been canceled without prejudice/disclaimer to the subject matter embodied thereby. These rejections are respectfully traversed for the following reasons.

The Examiner maintains the pending rejection by asserting that the claimed feature "that the timing at which the first switching element is turned ON/OFF and the timing at which the second switching element is turned ON/OFF are the same" is a functional limitation and merely requires the ability of the driver to be capable of performing the recited function. This assertion is respectfully traversed. As noted by the Examiner, it has been held by the courts that "apparatus claims cover what a device is, not what a device does." As a preliminary note, for the reasons that follow, it is respectfully submitted that the claimed timings define what the device is. Nonetheless, it is respectfully submitted that the Examiner's relied-on holding is limited to the specific fact situation whereby claim language defines only an intended use *without the requisite structure to carry out the function*. The court holding does NOT stand for the broad proposition that functional language *per se* is not given patentable weight. Moreover, there is no basis for the position that functional language only requires the prior art to be capable of performing the recited function.

The Examiner is directed to MPEP 2173.05(g) which sets forth the applicable standard for giving full patentable weight to functional limitations:

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.

In the instant case, claim 3 recites in pertinent part, “a control section for controlling a potential at the output node of the constant current section to a prescribed potential by negative feedback control, so that the timing at which the first switching element is turned ON/OFF and the timing at which the second switching element is turned ON/OFF are the same.” Accordingly, it is submitted that the recited timings define the “structure” of the claimed device in functional terms. For example, the control section must be arranged and/or configured and/or connected in such a way to effect the claimed timings. Such an arrangement/configuration/connection structurally defines the control section in functional terms, and must therefore be given **full** patentable weight “just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.” Accordingly, a proper 102 rejection would require the prior art to necessarily disclose the claimed timings, not just be capable of obtaining them.

Indeed, MPEP 2173.05(g) cites to *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971), which provides an example whereby a functional limitation is given **full** patentable weight because “it set definite boundaries on the patent protection sought.” In the instant case, it is respectfully submitted that the claimed timings sets definite boundaries on the patent protection sought. In particular, claim 3 defines “a control section for controlling a potential at the output node of the constant current section to a prescribed potential by negative feedback control, so that the timing at which the first switching element is turned ON/OFF and the timing at which the second switching

element is turned ON/OFF are the same.” To emphasize this point, the claim defines a manner by which the control section controls (i.e., by negative feedback control).

One of ordinary skill in the art would readily recognize at least one arrangement/configuration/connection needed to provide the recited function, whereas Soumyanath is completely silent as to such an arrangement/configuration/connection. As acknowledged by the Examiner, Soumyanath fails to disclose or suggest a control section arranged/configured/connected so that the timing at which the first switching element is turned ON/OFF and the timing at which the second switching element is turned ON/OFF are the same.

Only Applicants have conceived of such a structure. Indeed, the structure recited in claim 3 can allow the potential of the substrate to not be controlled. Accordingly, even in a silicon LSI normally having a common substrate, it is possible to adjust the on-resistance value of the switching element without influencing other circuits. Soumyanath is silent as to such effects and provides no motivation for obtaining them

As set forth in the aforementioned MPEP section, the alleged capability for Soumyanath to provide the recited timings is irrelevant to the determination of the patentability of claim 3. As is well known in patent prosecution, "inherency may not be established by probabilities or possibilities" (*see Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)); and anticipation under 35 U.S.C. § 102 requires that ***each and every element*** of the claim be disclosed, either expressly or inherently, in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Soumyanath does not anticipate claim 3, nor any claim dependent thereon.

Moreover, “[t]he mere fact that references can be combined or modified does not render a resultant combination obvious unless the prior art also suggests the desirability of the combination.

See *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). In the instant case, Soumyanath does not "suggest the desirability of the claimed combination." The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in the pending claims because the cited prior art fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 3 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 102/103 be withdrawn.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are

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any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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